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TECHNOLOGY CENTER 3600

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)  
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PORT WASHINGTON, WI 53074

In re Application of	:	
James Brinsfield et al.	:	DECISION ON PETITION
Application No. 09/689,374	:	UNDER 37 CFR §1.181
Filed: October 12, 2000	:	
Attorney Docket No.: GEMS80813041	:	
For: MOBILE CLINICAL INFORMATION	:	
SYSTEM	:	

This is a decision on applicant's petition under 37 CFR 1.181 filed August 21, 2006 requesting that the amendment under 37 CFR 1.116 filed July 31, 2006 be entered.

The petition is **DENIED**.

The record reflects that on June 1, 2006 a Final Office action was mailed rejecting claims 1-31 under 35 U.S.C. 103(a). On July 31, 2006 applicant filed an amendment under 37 CFR 1.116 amending claims 1 and 26 and canceling claim 29. On August 15, 2006 an Advisory Action was mailed denying entry of the amendment filed July 31, 2006.

In the petition filed August 21, 2006 requesting entry of the amendment under 37 CFR 1.116 filed July 31, 2006, applicant argues that the refusal to enter the amendment is improper because: (1) the amendment to claim 1 merely corrected a typographical error; (2) the amendment to claim 26 does not raise any new issues since the proposed claim changes merely incorporate the subject matter of claim 29; and (3) incorporating the subject matter of claim 29 into claim 26 reduces or simplifies the issues on appeal.

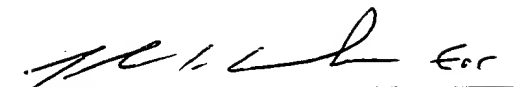
37 CFR 1.181(f) states: The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provide. This two-month period is not extendable.

MPEP 714.12 sets forth that, "Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP 706.07(f), 714.13 and 1207".

MPEP 714.13 (III) sets forth that, "The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or where the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents a new issue requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issue that would require further reconsideration and/or search. The reasons for nonentry should be concisely expressed. For example: (A) the claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal".

With regard to applicant's argument that the refusal to enter the amendment is improper because incorporating the subject matter of claim 29 into claim 26 does not raise any new issues, although the proposed changes would not raise any new issues with respect to claim 26 as amended, because claims 27, 28, 30, and 31 depend from claim 26, these dependent claims incorporate all of the limitations of claim 26. Since dependent claims 27, 28, 30, and 31 did not previously incorporate the subject matter of claim 29, by amending claim 26 to incorporate the subject matter of claim 29, the proposed changes would raise new issues that would require further consideration with respect to claims 27, 28, 30, and 31. With regard to applicant's argument that the refusal to enter the amendment is improper because incorporating the subject matter of claim 29 into claim 26 reduces or simplifies the issues on appeal, since, as described above, the proposed changes raise new issues in dependent claims 27, 28, 30, and 31, the issues on appeal would not be reduced or simplified. Finally, although the proposed changes to claim 1 merely correct a typographical error, because the amendment as a whole raises new issues that require further consideration, this argument alone is not found to be persuasive. Accordingly, the non-entry of the amendment filed July 31, 2006 is considered appropriate as: (1) the amendment did raise new issues and (2) the proposed changes do not place the case in condition for allowance or in better condition for appeal.

The petition is **DENIED**.

A handwritten signature in black ink, appearing to read "Wynn W. Coggins", is written over a horizontal line.

Wynn W Coggins, Director  
Patent Technology Center 3600  
Telephone No.: (571) 272-5350

Cg/snm: 3/29/07

Handwritten initials "SM" in black ink.